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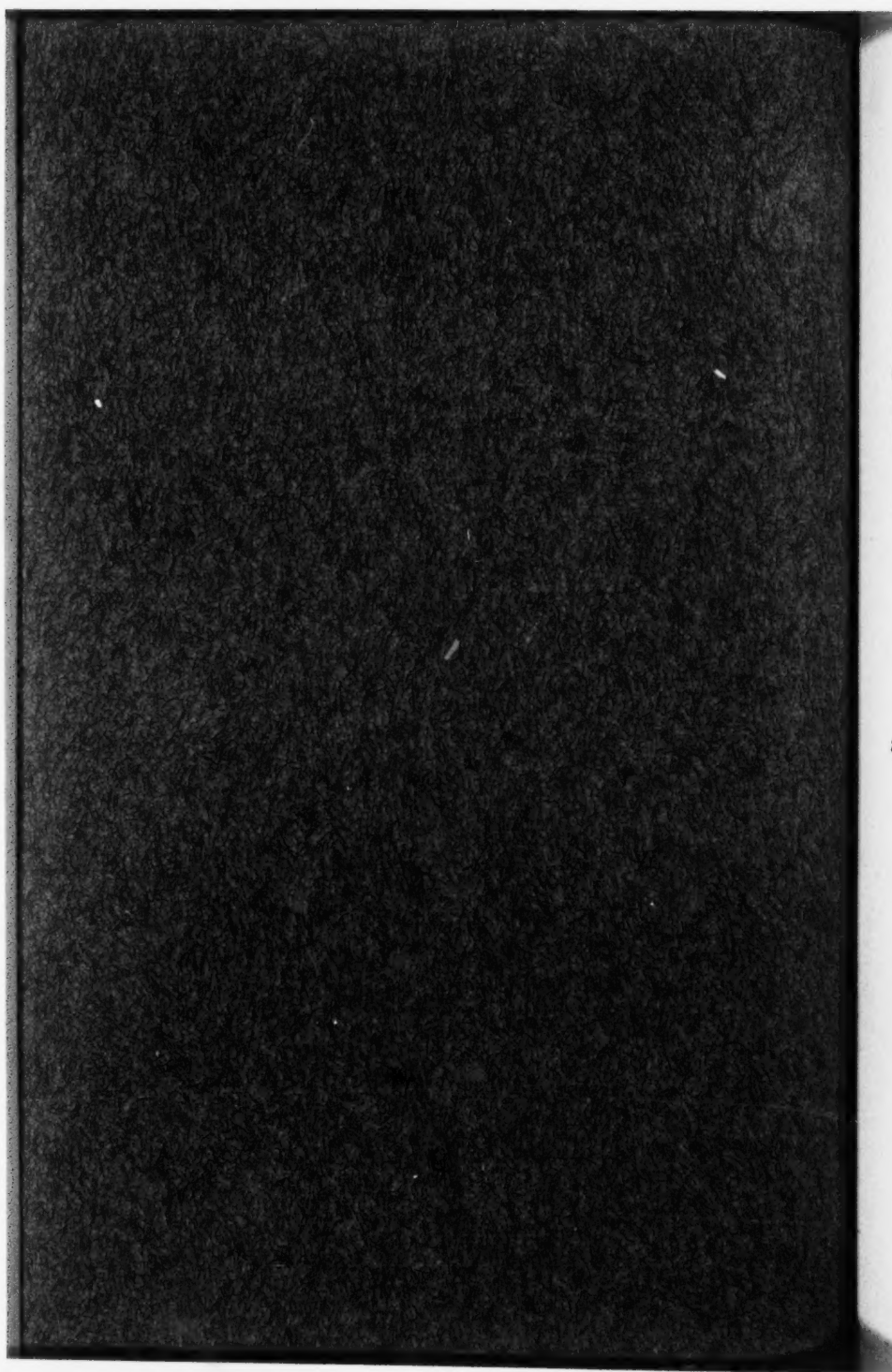
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(1)



In the Supreme Court of the United States

OCTOBER TERM, 1944

Nos. 599-600

OTTO LIND AND THE PROCTER & GAMBLE COMPANY,
PETITIONERS

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR WRITS OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The United States District Court for the District of Columbia entered judgments (R. 7)¹ without an opinion, and made findings of fact and conclusions of law (R. 8-13). The *per curiam* opinion of the United States Court of Appeals for the District of Columbia, affirming the judgments of the district court, is reported in 143 F. (2d) 26 (cf. R. 192-193). The petition for rehearing was denied (R. 193).

¹ Herein, the record is cited "R."; findings of fact as "F."; and conclusions of law as "C."

JURISDICTION

The judgments of the Court of Appeals were entered on June 19, 1944 (R. 192-193). The petition for rehearing was denied on July 18, 1944 (R. 193). The petition for writs of certiorari was filed on October 16, 1944. The jurisdiction of this Court can be invoked under Section 240 (a)² of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the court below erred in sustaining the district court's finding that the claims in the patent applications here involved were unpatentable over the prior art.

2. Whether the district court, in a proceeding under R. S. sec. 4915, may hold unpatentable over the prior art, claims for which a patent was previously denied in the Patent Office on the ground of estoppel.

STATUTE INVOLVED

R. S. sec. 4915, as amended, provides in part:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action

² Section 239 cited by petitioners (Pet. 3) is not pertinent.

may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. * * * In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. [35 U. S. C. 63.]

STATEMENT

The pertinent facts may be summarized as follows:

Petitioners filed two patent applications directed to detergent compositions particularly adapted for washing in hard water, and comprising an alkali metal salt of pyrophosphoric, triphosphoric or tetraphosphoric acid, together with other known detergent ingredients (R. 2, R.

8; F. 3, R. 11). The Patent Office held that certain claims were unpatentable in view of the prior art, and that petitioners were estopped to obtain a patent for several other claims.³

Petitioners then brought these suits in the district court under R. S. sec. 4915 (35 U. S. C. 63), to compel the grant of a patent on such claims (R. 2-3). The Commissioner of Patents defended on the ground that all the claims involved were unpatentable over the prior art (R. 5-6),⁴ and on the further ground that claims 1, 2, and 3 of Application No. 234,952 were barred to petitioners by estoppel (R. 5).

The district court found, from the prior patents cited in the answer (R. 81-145), that it was "old in the art to use alkali metal phosphates, metaphosphates, orthophosphates, and pyrophosphates, together with soap and detergents, as cleaning compositions" (F. 6-16, R. 9-10; F. 4-14, R. 11-12); and that although "No disclosure of the use of a synthetic detergent and an alkali metal triphosphate or tetrphosphate is found in

³ The Patent Office held unpatentable claims 9, 10, 11, 15, and 16 in Application Serial No. 234,952 (R. 164-168) and claim 15 in Application Serial No. 752,462 (R. 168, 176, 180); and held claims 1, 2, and 3 in Application Serial No. 234,952 barred by estoppel (R. 150-153). The other claims rejected were abandoned during the proceedings below.

⁴ The answer in the case involving Application No. 752,462 (not included in petitioners' record) put this ground in issue as to the claim therein; the amended answer in the case involving Application No. 234,952 (R. 5-6) did likewise.

the prior art," "no invention was involved in making a similar use of alkali metal triphosphates and tetrphosphates" (F. 17, R. 10; F. 15-16, R. 12-13). The district court accordingly held that all the claims in issue were unpatentable over the prior art (F. 19, R. 10; C. 3, R. 10; F. 17, R. 13; C. 1, R. 13). As to the action of the Patent Office disallowing three of the claims on the ground of estoppel, the district court disagreed as to two and agreed as to one (C. 1, 2, R. 10). The judgments dismissing the complaints (R. 7) were affirmed by the court below in a *per curiam* opinion (143 F. (2d) 26; cf; R. 192-193).

ARGUMENT

The only substantial issue presented, *viz.*, the patentability of claims over the prior art, is one not generally reviewed by this Court except to resolve a conflict of decisions between circuit courts of appeals on the same patent (*Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387²⁸⁸), and no conflict is alleged.

1. Petitioners contend (Pet. 13, 18) that having found that the prior art did not disclose "the use of a synthetic detergent and an alkali metal triphosphate or tetrphosphate" (R. 12), the district court erred in concluding that there was lack of invention. The district court's findings adequately answer this contention.

Petitioners do not dispute the finding that the use of "alkali metal phosphates, metaphosphates, orthophosphates and pyrophosphates, together with sodas and detergents, as cleaning compositions" was known to the prior art (see Statement, *supra*, p. 4). Petitioners' expert witnesses Byerly and Quimby testified (R. 27, 35) that in their opinion "the prior art use of metaphosphates, orthophosphates and pyrophosphates as ingredients of cleansing compounds might have suggested experimentation with alkali metal triphosphates and tetraphosphates as ingredients of such compounds." The court thus properly found that "no invention was involved in making a similar use of alkali metal triphosphates and tetraphosphates" (R. 12-13). This finding is supported not only by the testimony of petitioners' witnesses, but also by the common knowledge of the art.⁵

⁵ It is well known to chemists that members of the phosphoric acid family are all derived from phosphorus pentoxide by chemical combination therewith of various amounts of water. Orthophosphoric acid is the member of the group in which the most water is combined. Pyrophosphoric acid has less water combined in it. Metaphosphoric acid has still less. The members of the family having water combined in them in amounts extending from that of the pyrophosphoric acid to that of the metaphosphoric acid are known in the art as "polyphosphoric acids" and their alkali metal salts are known as "alkali metal polyphosphates." The "triphosphate" and the "tetraphosphate" are polyphosphate members of the family lying between the pyrophosphate and the metaphosphate as regards the amounts of water combined in their acids, and these and other members of the polyphosphate group are well known in science. (See R. 87-90, 43-44, 53.)

2. Petitioners assert (Pet. 13-15) that since the Patent Office's action in rejecting two of the claims in suit on the ground of estoppel was found erroneous by the district court, it erred in holding those claims unpatentable over the prior art when the Patent Office had not based its rejection on that ground.

This contention is unsound. The suits in question, brought under R. S. sec. 4915 (*supra*, pp. 2-3), were trials *de novo*, not limited to the record in the Patent Office, and all defenses set up in such proceedings—including the defense of unpatentability raised in the Commissioner's answers (R. 5-6)—are to be considered by the court. *In re Hein*, 166 U. S. 432; *American Steel and Wire Co. of N. J. v. Coe*, 105 F. (2d) 17 (App. D. C.); *Gerhardt v. Goserud*, 24 F. Supp. 161 (D. Minn.).⁶ Indeed, patentability is "the question of primary importance" in cases under R. S. sec. 4915, since the court must be satisfied that the claims are patentable before it may adjudge the applicant entitled to a patent. *Hill v. Wooster*, 132 U. S. 693, 698; *Radtke Patents Corporation v. Coe*, 122 F. (2) 937, 940 (App. D. C.), certiorari

⁶ The reference to an administrative appeal (Pet. 6) and the authorities cited as to such an appeal (Pet. 15) have no relevancy, for the proceedings here were trials *de novo* rather than administrative appeals.

denied, 314 U. S. 695; see *Fessenden v. Coe*, 99 F. (2d) 426, 452 (App. D. C.)¹

CONCLUSION

The decisions of the courts below were correct and turn upon a finding of fact. There is no conflict of decisions. It is therefore respectfully submitted that the petition for writs of certiorari should be denied.

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NOVEMBER 1944.

¹ The last assignment of error (Pet. 14) is based purely on conjecture as to the mental attitude toward the question of invention allegedly held by the courts below. The record exhibits no evidence of bias, and none is cited.

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